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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/624,518

07/23/2003

Shun-Hsiang Ke

BHT-3111-344

7438

7590

08/07/2006

BRUCE H. TROXELL

SUITE 1404

5205 LEESBURG PIKE

FALLS CHURCH, VA 22041

EXAMINER

JACKSON, MONIQUE R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/624,518

Applicant(s)

KE ET AL.

Examiner

Monique R. Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group II in the reply filed on 5/22/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Considering all the claims of Group I have been cancelled, the Applicant's election is moot. The Examiner would like to note that the Applicant failed to completely respond to the restriction requirement in terms of the election of species, however, in view of the below rejections, the Examiner hereby withdraws the election of species requirement.

Specification

2. The substitute specification filed 11/7/05 has been entered however it is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: at page 5, lines 15-17 of the substitute specification, the text of the specification has been changed to recite that the conductive particles 220 are "mainly composed of 1-Butanol, Ethanol, Ethyl acetate (EAC), Hexane, Isopropanol (IPA) 80%, and partial acrylic resin" however it is noted that the recited section should actually refer to the resin A, as recited in the original disclosure, not the conductive particles. Further, the Examiner questions why the solvent terms are capitalized. Are they specific brands or particular named solvents? If the terms refer to the generic solvents, then they should not be capitalized.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 35-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. At lines 13-15, Claim 35 recites the limitation “an upper exterior of selected first conductive particles of the plurality of first conductive particles **communicating** with an exterior of an upper surface of the solidified resin B” (emphasis added) however the original disclosure at the time of filing does not provide support for the particles to “communicate” with an exterior of an upper surface of B.

5. Claims 35-39 and 41-42 are further rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A protection film comprising a resin B coating comprising a plurality of “tiny particles”, namely silicon oxide particles as recited in Claim 40, located in an upper portion thereof, and wherein the resin B is a different resin than resin A, namely a “harder” or “hardcoating” resin, are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). According to the instant disclosure at the time of filing, the apparent novelty of the invention appears to be a protection film that provides both antiglare and antistatic properties, wherein the antistatic properties are provided by the

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conductive particles and the antiglare properties are provided by the “tiny” silica particles in resin B located in an upper portion thereof.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 35-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 35 recites the limitation “an upper exterior of selected first conductive particles of the plurality of first conductive particles **communicating** with an exterior of an upper surface of the solidified resin B” (emphasis added.) Considering the original disclosure at the time of filing does not utilize the term “communicating”, it is unclear what is meant to be encompassed by the limitation particularly since the particles are not capable of “communicating” as the term is accepted in the English language and in the art.

8. Claim 41 is further unclear in that it recites the limitation “protection film according to claim 35, wherein the resin A includes 1-Butanol, isopropanol, and acrylic resin having a solid content of the resin A is 5 to 25% by weight”. Since the protection film of claim 35 appears to be a final product with solidified coating layers, it is unclear whether the Applicant is reciting that the first resin layer is formed from a coating including the recited materials or whether the Applicant is actually reciting that the final product includes 1-butanol and isopropanol. Further the phrase “acrylic resin having a solid content of the resin A is 5 to 25% by weight” is unclear. Based on the original disclosure at the time of filing, it appears as if resin A coating has a solid content of 5 to 25% by weight” not the acrylic resin or resin A itself. Similarly, Claim 42 recites

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“wherein the resin B is an acrylic resin having a solid content of the resin B is 45% to 50% by weight” and is unclear for the same reasons.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Koyama et al (USPN 6,572,961) teaches a transparent hard coat film containing at least two inorganic particles of different particle sizes. Chien et al (USPN 6,852,376) teach an antiglare film comprising two different particles dispersed in a resin coating on a substrate. Suzuki et al (USPN 6,319,594) teach a low reflective antistatic hardcoat film comprising a hardcoat layer with different sized particles. Yoshihara et al (USPN 6,376,060) teaches a hardcoat film comprising a first inorganic filler having a particle diameter of 0.01 to 0.3 microns and a second inorganic filler having a particle diameter of 0.3 to 10 microns.

Allowable Subject Matter

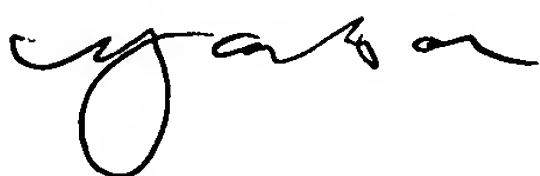
10. The Examiner believes that if the claims were rewritten or amended to address the above rejections, the instant application would contain allowable subject matter over the closest prior art disclosed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Monique R. Jackson
Primary Examiner
Technology Center 1700
August 3, 2006